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IN THE

Supreme Court of the United States

OCTOBER TERM, 1927.

No. 235.

HOLLAND FURNITURE COMPANY,
Petitioner,

vs.

PERKINS GLUE COMPANY,
Respondent.

REPLY BRIEF FOR RESPONDENT.

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March 20, 1928.

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Respondent.

REPLY BRIEF FOR RESPONDENT.

We believe the reply brief filed by defendant (Petitioner) calls for some comment, for the position taken by defendant therein seems untenable.

Defendant now alleges (Reply Brief, p. 1) that it was not its position below that the product claims are limited to process features and it alleges that the Court below erred in assuming that to be the fact. Now we submit the Court below did not err in this respect and we submit it was defendant's position below that the product claims are limited to process features, for on page 2 of its Brief below, after referring to its contention that the prior art disclosed the treatment of raw starch, defendant's counsel said:

> "It is also **defendant's position** that the inventive thought disclosed in the patent affirmatively rejected

> and the patent did not cover, such treatment of raw starch; that the **idea of the patent comprehended a two-step process in which the first step consisted in treating the raw starch to reduce its viscosity to within a defined and measurable range**, and the second step, old in its application to raw starch, consisted in dissolving this degenerated starch in the caustic solution, containing three parts or less of water, to make glue."

This was the position taken by the 2nd C. C. A. in the Standard Case and the 7th C. C. A. in the Wisconsin cases on which defendant allegedly relies, but defendant now finding this position untenable, attempts to shift its position.

Defendant says "Perkins' product cannot be identified by the use to which it is put." It may be that if the product claimed is, *per se*, old, a product claim therefor cannot be sustained on the ground that it is applied to a new use. But we contend that the product here claimed is new in and of itself and independently of the use to which it is put, and independently of whether it be made from a base coming within the so-called 9 to 1 boil up and 170° tests.

The Characteristic That a Product Has the Properties of Another Product or the Capability of Doing a Certain Thing or Things May Be Used as an Identifying Characteristic in the Claims.

Defendant, however, further says (Rep. Brief, p. 1) that Perkins' product cannot be identified by "its ability to do the work of animal glue." This is a different proposition. If by this it is meant that a new product may not be distinguished from the prior art by a statement of its having the properties of a certain other product or by a statement of its having the capability of doing a certain thing or things, then defendant's position is not sustained by any authority and is negatived by many authorities which might be cited *ad nauseum*.

For example, in Dick Co. vs. Underwood, 246 Fed., 309 (affirmed 252 Fed., 990), one of the essential characteristics of certain of the product claims in suit was

> "a stencil blank capable of being stencilized."

In Parke, Davis Co. vs. Mulford, 189 Fed., 95, one of the identifying characteristics of claim 2 there in suit was

> "a substance possessing the herein-described physiological characteristics and reactions of the suprarenal glands in a stable and concentrated form," etc.

In General Electric vs. Laco Philips, 233 Fed., 96, the 2nd C. C. A. held valid claim 3 which, as one of the identifying characteristics, stated that the filament was

> "capable of incandescent efficiency at the rate of less than 1 watt per candle power and substantially free from perceptible disintegration at that efficiency."

In Byerley vs. Sun Co., 181 Fed., 138 (affirmed 184 Fed., 455), claim 2 was held valid and identified the new petroleum product as one having, among other characteristics, the

> "characteristics belonging to asphaltic residual products from a prolonged exposure of petroleum tar to a pitch-forming non-coking temperature in a still with agitation of said tar, and exposure of the same to air in contradistinction to previously known material or artificial products of a more or less asphaltic character, substantially as set forth."

In Sackett Co. vs. Rutkowsky, 167 Fed., 138, claim 3 for a substitute for lath and plaster, contained as one of the identifying characteristics,

> "the boards being stiff, and firm, but sufficiently soft to admit the driving of nails through them to fasten them to the studding, substantially as set forth."

In General Electric vs. Lamp Co., 266 Fed., 994, one of the claims for an incandescent lamp had as its identifying characteristic,

> "the filament being sufficiently large and the heat conductivity of the filling being sufficiently poor to permit the lamp to be operated with a filament temperature in excess of that of a vacuum tungsten lamp operating at an efficiency of one watt per candle and with a length of life not less than that of such a lamp,"

and as to the claim of indefiniteness, the Court said (p. 1000):

> "It was unnecessary to do more than state the limits of invention in terms of result, because the results desired are not functional, and do indicate limits in terms of lamp life and candle power which are likewise presumably quite familiar to any competent electrician."

In Sporting Goods Co. vs. Haskell Co., 217 Fed., 407, the claim for a golf ball identified the enclosing shell of gutta percha as

> "of such thickness as to give it the required rigidity."

In Hoskins Co. vs. General Electric, 212 Fed., 422 (affirmed 224 Fed., 464), one of the product claims sustained identified one of the ingredients of the alloy as

> "more than 50 per cent. of metal having the properties of nickel and cobalt."

In Standard Co. vs. American Co., 203 Fed., 508, the product claim stated the product was a black, semi-solid asphaltic flux, etc.,

> "possessing the characteristics of a product obtained by prolonged exposure of petroleum residuum," etc.

In Goodwin Co. vs. Eastman Co., 213 Fed., 231, the 2nd C. C. A. held claim 10 valid, which defined one of the essential characteristics of the photographic film as a film possessing

> "the following essential properties of glass-plate supports, viz., insolubility in developing fluids, insensibility to heat and moisture, imporosity of structure, and hardness, smoothness, and brilliancy of surface."

When the claims characterize the glue as a wood and fiber glue or as a glue having the properties of animal glue, that is not referring to its use. That is characterizing the glue, not by the use to which it may or may not be put, but by its physical characteristics, and it is by the **combination** of such physical characteristics, with the statement of ingredients and proportions set forth in the claims that the product is differentiated from the prior art and infringement is to be determined.

There Is No Rule That Limits a Patentee as to the Manner in Which he Shall Distinguish His New Product from the Prior Art.

The courts have very properly refrained from laying down any rule as to the manner in which a new product shall be claimed. This is not only wise, but necessary, for new product inventions are constantly appearing which require that they be claimed in a new manner if the patents are to give protection commensurate with the actual invention. A patentee should not be forced by arbitrary rules to limit his claims so that they may not cover the invention to its fullest extent.

The identifying characteristics used are numerous and vary widely in character, and new ones are constantly appearing. In the past identifying characteristics have in-

cluded (1) a statement of certain ingredients, (2) a statement of certain proportions in respect of one or more of the ingredients, (3) a statement that the product has certain properties, i. e., is capable of doing certain things, (4) a statement that the product responds to certain tests, either physical or chemical or both.

The product may be claimed solely by any one or more of the above, and the novelty may lie in one or more of the characteristics specified in the claim, or if the claim specify a combination of any two or more characteristics each of the characteristics may be old, *per se*, in which case the novelty consists in providing a product having such combination of characteristics. (The great variation in the manner of claiming new products is illustrated by the cases hereinbefore cited as well as by the cases cited in the "Appendix" at the end of this brief.)

So in the case at bar (1) glue having substantially the properties of animal glue was old, i. e., animal glue; (2) a wood and fiber glue was old, i. e., animal glue; (3) a glue formed of a starchy carbohydrate or containing amylaceous (starch) material was old, e. g., the Gerson & Sachse or Dorneman weakly adhesive sizes; (4) a glue containing 3 or less parts of water was old, i. e., animal glue; (5) a glue containing alkali metal hydroxid (caustic alkali) was old, e. g., Gerson & Sachse or Dorneman; (6) a viscous semi-fluid and unjellified glue was old, i. e., animal glue. But no one before Perkins had combined these characteristics in a single product as specified in the claims in suit. No one before Perkins had provided (1) a wood and fiber glue or a glue having substantially the properties of animal glue and which was also composed of (2) starch and (3) water and (4) caustic alkali, and (5) the proportion of the water being about 3 parts or less, and it was by so combining such a plurality of characteristics as set forth in the claims that Perkins revolutionized the art of furniture veneering gluing and saved the industry millions of dollars yearly.

Defendant's Objection That the Claims Are Bad as Being for a Result Is Untenable.

Practically every product is the **result** of some process or processes, but it is nevertheless still patentable as such, for this Court in Rubber Co. vs. Goodyear, 76 U. S., 788, after stating that a machine and its product are independently patentable, said:

> "The same remarks apply to processes and their **results.** Patentability may exist as to either, neither or both according to the fact of novelty or the opposite."

Defendant's counsel confuse this well settled rule of law with the rule that a **function of a machine** is not patentable as such. On page 6 of their brief they cite the Corn Planter Patent, 23 Wall., 181, and the objection there was that the claim was merely for the **function of a machine**, although in that case called a result. The cases of Electric R. Signal Co. vs. Hall, 114 U. S., 87; Hobbs vs. Beach, 180 U. S., 383; Westinghouse vs. Boyden, 170 U. S., 534, and Mitchell vs. Tilghman, 19 Wall., 287 (also cited in Defendant's Reply Brief), are distinguished in the same manner.

Defendant's Glue Is Not a Heavier Glue Than That of the Patent.

It is obvious that even following the particular two step process which Perkins described in great detail in his patent, that the resulting product would vary considerably in viscosity. For example, he specifies the use of a range of water from 1 to 3 parts and, of course, the viscosity of the resulting Perkins' final glue will vary accordingly. Also even the so-called 9 to 1 boil-up test and 170° test permit of considerable variation in the viscosity of the starch base to be used. For example, according to the 9 to 1 boil-up test, a base may be used which registers between 16 and

48 on that test (Rec., p. 250, line 2 and line 25). These preferred ranges, therefore, necessarily result in the production of final glues of different viscosities when following the preferred examples set forth in the Perkins' specification. This is all conceded by defendant's expert. Thus defendant's expert after referring to the product produced by dissolving the Gerson & Sachse base in Perkins' proportion of water and comparing this with one sample of Perkins' final glue, said (Rec., p. 184) the Gerson & Sachse base "makes a thicker product, made up in exactly the same way," but to demonstrate that it was still within the Perkins' descripton, he said

> "there is a range within the description which Perkins has given in his patent, there is quite a wide range of possibility, and the thing that is appreciably thicker in mixture than his product may still come within his description."

The experts on both sides are entirely in accord on this point. Plaintiff's expert, Dr. Grosvenor (Rec., pp. 72, 73), in comparing the **usual** viscosity of Perkins' glue with the **range** of viscosity of certain of Perkins' glues which he had observed by varying the length of agitation and heat, etc., stated that he had seen "the actual viscosity of the glue itself" by such adjustment of length of agitation and heat, vary from 250,000 to 60,000, whereas the "**usual**" viscosity of Perkins' commercial product was "in the vicinity of say 125 or 126,000; it swings somewhat up and somewhat below that; that is purely a question of the practical working of the glue on the veneers" and defendant's finished glue was 156,000, i. e., right in the middle of the range indicated by the tests made by Dr. Grosvenor on certain samples of Perkins' glue.

Therefore, defendant's statement of Dr. Grosvenor's testimony (p. 37 of Defendant's Reply Brief) is misleading. They there merely compare the viscosity of defendant's glue with the **usual** viscosity of Perkins' **commercial** product and ignore the fact the patent indicates a wider range

as testified to by both experts and that the viscosity of defendant's glue falls well in the middle of this range.

Defendant's counsel (p. 36 of their Reply Brief) refer to Grossman's testimony (Rec., pp. 51-52, 59-61) and allege he testified that the Kane base makes a much heavier glue than Perkins, requiring special machinery to handle it and that defendant's glue in the spreading machine is heavier than the Perkins' glue. This, we submit, is contrary to the testimony of defendant's own witness Stephan, who was the manager of the defendant, for in comparing defendant's Kane glue here involved with Perkins' glue, which he had also used, he said (Rec., p. 403):

> "So far as I know it was all used in practically the same way and mixed up practically the same. It was all used for the same general class of work and all put on in the regular way with the same spreaders, same machinery. So far as I know it all behaved the same way."

We submit Grossman's testimony referred to does not warrant the conclusions stated by defendant's counsel. Grossman's testimony (Rec., pp. 51-52) is addressed to the behavior of the mixture during the early stages of the process and not to the glue when finished. He says:

> "Our stuff is heavier, and the heavier the glue base from a business standpoint of viscosity, the quicker it drops to the bottom of the kettle, **before it is cooked up.**"

In other words, he is referring to the condition **before the glue is cooked up** and not after the dissolving is completed. It is true that Grossman also states (Rec., pp. 60, 61) that

> "our glue **base** cooked up—and put in a spreading machine, is heavier than the Perkins glue **base**, proving that there is less degeneration in a raw hard starch than one which has been treated and softened." * * *
>
> "It is heavier for the same amounts of water added."

Grossman may have been referring to the base only, but, if not, he was obviously comparing defendant's glue **only** with **commercial** samples of Perkins' glue when mixed with one given amount of water, and not with the range of water and viscosity permitted under the Perkins' description as hereinbefore pointed out.

That is to say, defendant's only attempt to distinguish the finished glues is to assert that defendant's glue is somewhat heavier than the particular commercial samples of Perkins which were used for comparison. None of defendant's witnesses testified that defendant's finished glue was in any way different from glue which would fall within the Perkins' range (as to the glue). This was agreed to, as above pointed out, by the experts for both sides.

Regarding the statement that special machinery is required to mix defendant's glue, this merely means that the mixture may be somewhat heavier in the first stage of the dissolving process. It does not mean that there is any difference in the glue when it is finished. When finished, both glues are used on the same kind of spreading machinery, and even as to the dissolving operation, defendant's witness Grossman admits (Rec., p. 59) that

> "where a man contemplates a change from the Perkins to the Kane base, he tries it out on a Perkins convertor."

And defendant's witness Stephen admits that both glues "mixed up practically the same" and were "put on in the regular way with the same spreaders" (Rec., p. 403).

Judge Sessions, before whom the case was tried, after hearing the testimony of Mr. Grossman referred to, and seeing the witness, found as a fact that "defendant's **final** product * * * **is identical with the glue of the patent**" (Rec., p. 339).

Defendant's Glue is Identical With the Glue of the Patent.

The claims in suit are on their face limited to a "wood and fiber glue" or a glue "having substantially the properties of animal glue." The meaning of these terms is made very clear in the specification. Thus the patent states (Rec., p. 250, line 113):

> "In the preferred form described, my improved glue is transparent and free from odor, and is very stable after mixing for use, it is instantly adhesive to clean surfaces, its cohesion is very great but not sufficient to overcome its adhesion and its viscosity is lasting and low enough to permit ready application, but so proportioned to its cohesion that it is capable of being applied by machinery like hide glue, but still very long, tough fibers are produced if freshly joined surfaces are separated. I have found that, owing to the breakage of these filaments, quick separation of such surfaces produces a crackle like electric sparks.
>
> My glue will produce joints which are practically unaffected by natural humidity and which are unaffected by prolonged dry heat."

The patent makes it clear (Rec., p. 248, line 73, and Rec., p. 247, line 92) that although other starches may be used, cassava starch is preferred, and (Rec., p. 249, lines 91-103) less than about 3 parts of water with the caustic solvent is used, yet the resulting glue has "a semi-fluid consistency" much superior to that obtained by the use of water alone and which is not "jelly-like and tough," the alkali uniting with the starch and small amount of water forming a glue "of very tenacious properties."

The patent further points out (Rec., p. 248, line 113, and p. 249, line 35) that the new glue is a colloidal compound, and by comparison with prior art starch adhesives, that the new glue (Rec., p. 250, line 104)

> "parallels the animal glue solutions now employed industrially, in respect to water contents and physical

> properties in application, and is equal or superior as to strength and permanency,"

and instead of being unfit for "wood joint work" like prior starch adhesives (Rec., p. 250, line 96) and containing so much water (Rec., p. 250, line 89) as to involve

> "changes in drying methods, or in drying time, or in risks of injury to the material due to warping by the extra water, all of very serious consequence."

the new glue is one which has (Rec., p. 247, line 27)

> "the necessary relative 'tack,' viscosity, cohesiveness and tenacity to spread and adhere properly when applied as wood glue,"

and is one which is not like (Rec., p. 247, line 39) the prior paste, etc., which is weak and diluted and which

> "has practically no power and would be wholly unfit for most classes of work, especially wood joints."

The new glue is one (Rec., p. 247, line 46) which does not

> "have the disadvantages just pointed out, but which will be exceptionally tenacious and powerful but still amply fluid for easy application, and which can be economically and easily produced,"

and (Rec., p. 247, line 100) produces a joint the

> "strength of which when dry is superior to the lateral strength of wood fiber. The prepared glue is very stable in its physical condition, so much so, that it may be kept for days or even weeks after it has been mixed for application without fermentative change,"

and (Rec., p. 248, line 3) the

> "glue is free from the complications which attend the use of an adhesive which must be cooked or warmed before use, or kept warm during use, and is more pow-

> erful than that which results from the treatment of starch in other ways. My improved glue when made in its best form and properly applied will not only tear away the wood at some point in the wood joint produced by the use of this glue, but will tear away the wood at many points whether with or against the grain,"

and (Rec., p. 247, line 53) the glue

> "may be practically used for the same purposes as the best animal glue, and possess certain great advantages of permanency to weather and temperature variations far superior to those of animal glue."

Plaintiff's expert not only testified positively that defendant's glue had all the characteristics contained in the claims in suit (Rec., pp. 37, 38), but he also testified (Rec., p. 38) that the final glue made by the defendant was

> "the same actual and industrial technical product as the final glue of the patent in suit,"

and (Rec., p. 35)

> "It had all the fluidity, penetration, adhesive and cohesive characteristics of the glue of the Perkins patent, and substantially all those of the animal glue for veneering work,"

and that it produced joints having the same high joint strength as produced by the Perkins glue. **Defendant introduced no testimony to the contrary.**

Instead, defendant's witness Stephan, manager of the defendant company, in comparing the characteristics of the various vegetable glues he had used, including not only Perkins glue, but also the so-called International glue (which defendant admitted to be an infringement) and the so-called Kane glue here involved, said (Rec., p. 403):

> "So far as I know it was all used in practically the same way and mixed up practically the same. It was all used for the same general class of work and all put on in the regular way with the same spreaders, same machinery. So far as I know it all behaved the same way; it behaved well."

Defendant's Base is Degenerated.

We believe we have conclusively demonstrated by the testimony of defendant's own witnesses that defendant's Kane base is very much degenerated (see pp. 92-97 of our Main Brief). We might add, however, that plaintiff's expert not only testified that it was degenerated (Rec., p. 36), but he also carried out a series of tests showing that while high viscosity starches prepared by him had viscosities of from 264 to 532, the defendant's Kane base on the same scale only had a viscosity of 95 to 105 (Rec., pp. 542, 543).

The experts agree that viscosity is a measure of the degeneration. Grossman admits that certain starches run as high as 200 to 220 (Rec., p. 518), and this was on modern starches, and the modern Royal showed a viscosity of 166 (Rec., p. 515), while the defendant's Kane base was much more degenerated. He at first alleged it had a viscosity of about 145 and never below 140 (Rec., p. 79), but in his later testimony he stated the viscosity of the Kane base to be 100 (Rec., p. 512) instead of 140, and he also stated that the Kane base ran uniform, i. e., it was an absolutely uniform product (Rec., p. 518). That is, the defendant's Kane base is one carefully **selected** for uniformly low viscosity. Every batch is checked up in the laboratory before being sent out, to be made into the glue (Rec., p. 518), and, in the language used by defendant's counsel, it is not "any" starch.

At pages 32, 33 of its reply brief, defendant refers to certain of the raw starches sent to Poplar Bluff about 1905, and plaintiff's argument in the Solva case that they were not degenerated and not usable to make the veneer glue without material degeneration, and defendant argues that it uses raw starch and, therefore, is using what plaintiff said was not usable. But defendant does not use any such high viscosity starch. Since 1905 the viscosity of cassava starches as they come on the market has been greatly re-

duced. Such high viscosity starches have not been available in later years (Rec., p. 41). The viscosity of the cassava starches as they come on the market has fallen off 40 to 50 per cent. on the average (Rec., pp. 42, 71). It was the high viscosity starches of 1905 and thereabouts which Perkins called "ordinary" and which he indicated as unsuitable without preliminary degeneration, and it was such high viscosity starches which plaintiff was differentiating in the Solva case. Defendant's starch base is very different. It is one of the modern cassava starches which comes on the market already sufficiently reduced in viscosity as explained in our main brief at pages 92-97.

Whether or not defendant's base falls within the two so-called tests, it is, under the patent law, the **full equivalent** of the Perkins preferred base for with it defendant obtains a final glue which (as the Court held) "is **identical** with the glue of the patent." Defendant's base is, therefore, "equally good" with Perkins preferred base and, therefore, as the Courts have stated, is the legal **equivalent** of Perkins preferred base for the purpose of making the final glue.

The Law Does Not Permit Defendant to Read the So-called 9 to 1 and 170 Degree Tests Into the Glue Product Claims.

We know of no rule which permits a patentee, when claiming a product independently of the process to characterize one of the ingredients by tests to which it can no longer respond. In the case at bar, when the glue is once made (even when made from a starch which at the start responds to the 9 to 1 and 170° tests) the starch can no longer respond to such tests for it has been changed by the dissolving process so that such tests are no longer applicable. Defendant refers (p. 2) to "choosing an ingredient of a specified degree of degeneration," but when the glue is once made the starch can no longer have any such specified degree of degeneration.

The specified degree of degeneration is a characteristic of the **process** not of the product. The process may be

characterized as one which starts with a base of the specified degree of degeneration, but it is impossible to characterize the glue as containing starch having the specified degree of degeneration, for in no case would the starch have the specified degree of degeneration in the final glue.

Defendant's attempt to read tests for the base into the glue product claims is, therefore, an attempt to read process features into the claims and not characteristics of the final glue product.

Defendants cannot so read limitations into the claims. This we have discussed at some length, beginning at page 132 of our main brief, but to the cases there cited we may add Howe Co. vs. Needle Co., 134 U. S., 388, 394.

The rule is necessary, otherwise how is the public to know what the claims cover. The 2nd C. C. A. in the Solva case and the 7th C. C. A. in the Wisconsin cases read the two-step process into the product claims, and not the so-called tests for the base. The defendant here now attempts to read the so-called tests for the base into the product claims and not the two-step process. Judge Geiger apparently attempted to partly read both sets of limitations into the product claims. The next infringer may omit some other detail of the process and attempt to read that into the claims to escape infringement. And there is no end to it. Each infringer cannot be permitted to pick out the particular non-essential details which he omits and have these read into the claims for the purpose of escaping infringement.

The Correct Interpretation of the Product Claims in Suit.

As stated at page 132 of our main brief:

> "The words in a claim may be interpreted where they are reasonably capable of different interpretations in order to determine what the language means, but we submit elements or features not referred to in a claim cannot legitimately be read into the claim for any purpose."

So when a product claim does not give proportions (and many of them do not), there is always implied the use of

suitable proportions. Likewise where a product claim has as one of its distinguishing features an ingredient falling within a certain class, there is implied the use of a **suitable** ingredient of that class. And in mechanical cases where a mechanical element is set forth in a claim without setting forth its mechanical connection to other parts, there is implied **any suitable** connection.

This was in effect the holding of this Court in the recent case of Temco vs. Apco, decided January 3, 1928 (apparently not yet reported). There the objection was raised that the claim was incomplete and void for want of a statement as to how the leaf spring was to be connected and guided, but this Court said:

> "Reading the claim with the specifications and the drawings, which are both clear (Howe Machine Co. vs. National Needle Co., 134 U. S., 388, 394), its addition to the combination of coiled springs interposed between the leaf-spring hangers having vertical movement and guided by stanchions comprehends the link as shown in the drawings **or any suitable connection** between each leaf spring and its hanger and casing surrounding the coiled spring which is interposed between the leaf spring and the axle and ground wheel. It does not seem to us that the claim is vague; nor do we find nullifying incompleteness in it. Turril vs. Railroad Company, 1 Wall., 491, 510; Rubber Company vs. Goodyear, 9 Wall., 788, 795; McClaim vs. Ortmayer, 141 U. S., 419, 425; Walker on Patents (5th Ed.), sec. 185."

In other words, the Court did not hold the claim limited to the particular arrangement illustrated in the specification, but held that it comprehended "any suitable connection" for the purpose.

The very fact that the so-called tests for the base were omitted from the product claims in suit shows that both the patentee and the Patent Office contemplated that the glue, as characterized in the claims, was covered when made from any suitable starch base.

Defendant on page 15 of its Reply Brief argues that the Court below erred in treating the claims in this manner,

but we submit the Court below was right when (in discussing defendant's contention that the claims must be limited to a specific starch base) it said (Rec., p. 649):

> "We do not agree. We are analyzing a result into its elements. Not to save from anticipation, but to make operative and intelligible, there is an implied limitation to that base which, when combined as stated, will give the result stated. In other words, out of the variety of starchy carbohydrates we must select one suitable for this combination. In this there is no forbidden vagueness."

The specification (not the claim) must, of course, describe at least one specific starch suitable for the purpose (and this it concededly does) in order that those skilled in the art may be advised of at least one way of reaching the result, but when the claims in suit are not limited to such details, such detils are not to be read into the claims even though without them the claims may be broad enough to cover an inoperative product as well as the new product. This Court in Deering vs. Winona, 155 U. S., 286, 302, said:

> "Defendants further insist that the twentieth claim of this patent is invalid, by reason of the fact that, if the board d^1 be construed, as it evidently must, as a board pivoted to the butt-adjuster, the combination is incomplete and inoperative, because the means by which it is held and controlled are not stated in the claim; and if the additional elements, namely, the arms d^2, d^3, and d^4 be read into it, it becomes the same as the twenty-first claim, and the novelty of the claim must be made to depend upon the peculiarities of the board d^1. Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. If Steward were in fact the first to invent the pivotal extension to a butt adjuster, he is entitled to a patent therefor, though the infringer may make use of other means than those employed by him to operate it. Webster Loom Co. vs. Higgins, 105 U. S., 580, 584 (26, 1177, 1179). In such case any appropriate means

> for making it operative will be understood. Otherwise the infringer might take the most important part of a new invention and, by changing the method of adapting it to the machine to which it is an improvement, avoid the charge of infringement. The invention of a needle with the eye near the point is the basis of all the sewing machines used; but the methods of operating such a needle are many, and if Howe had been obliged to make his own method a part of every claim in which the needle was an element, his patent would have been practically worthless."

And so in the case at bar, to read into the product claims the 9 to 1 and 170° tests is to render the patent absolutely worthless for it enables anyone to make the identical glue which Perkins first gave to the world in the easiest manner possible. This Court in Rubber Co. vs. Goodyear, 9 Wall., 788, 795, said, "a patent should be construed in a liberal spirit to sustain the just claims of the inventor," and

> "liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors. Corning vs. Burden, 15 How., 269; Battin vs. Taggert, 17 How., 75, 15 L. Ed., 37."

And in Klein vs. Russell, 19 Wall., 433, 466, this Court said:

> "The Court should proceed in a liberal spirit so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed."

And in Topliff vs. Topliff, 145 U. S., 171, this Court said a patent ought not to be defeated "by the application of artificial rules of interpretation." Under the facts as proved in this case, and considering the pioneer and revolutionary character of the invention and its great savings to the industry, and the liberal treatment which should be accorded such inventions as set forth in the decisions of this Court, we submit the interpretation given the claims by the Court below was right.

The Cases Cited in Defendant's Reply Brief.

Defendant cites Wood vs. Underhill, 5 How., 1. We submit this case supports our contention rather than defendant's. It is true that the court there said that the **specification** should state proportions sufficiently exact to enable others to make use of the invention, i. e., the **specification** must describe with sufficient detail at least one method of reaching the result, but the court did not hold that the patentee was limited to the precise proportions, etc., recited in the specification or that the **claim** must be limited to such precise proportions, etc. The claim gave no proportions and read as follows:

> "I claim as my invention the using of fine anthracite coal, or coal dust, with clay, for the purpose of making brick and tile as aforesaid, and for that only claim letters patent from the United States."

It being pointed out, however, that the specification suggested suitable proportions, etc. (although at the same time indicating that variations might be made), the Court said:

> "The Circuit Court, therefore, erred in instructing the jury that the specification was too vague and uncertain to support the patent, and its judgment must be reversed."

The defendant cites Minerals Separation vs. Butte, etc., 250 U. S., 336.

This Court (as therein indicated, p. 340) had previously held that the patent must be confined to the "proportions often described in the testimony **and in the claims** of the patent as critical proportions amounting to a fraction of 1 per cent. on the ore." The Court properly held the patentee limited to his **claims**. Applying the same principle to the case at bar, Perkins is limited to the 3 parts or less of water specified in the claims. That was the critical proportion and plaintiff is not seeking any broader construction.

We understand, however, that the court did not assume to find that the patent was limited to the particular oils mentioned in the specification, for indeed the holding of non-infringement was based on the finding that other and less effective oils would satisfy the claims, but since they were used in excess of 1% (the limitation in the claims) there was no infringement. The case, therefore, sustains our position that the claims are not limited to the particular quality of ingredients specified in the specification as preferred.

Defendant cites O'Reilly vs. Morse, 15 How, 62, where one of the claims was held invalid as being for a mere **function of a machine.** We have already pointed out that the function of a machine is to be treated differently from the product of a process.

Defendant cites Corning vs. Burden, 15 How., 252, in which the question also was as to whether the patent was for a machine or the function of a machine or process, and the Court held that Burden's patent was for a machine: Substantially the same may be said with respect to Carver vs. Hyde, 16 Pet., 513. The function of a machine may not be patentable as such but the result of a process, if new, is patentable as such. This was the holding by this Court in Rubber Co. vs. Goodyear, *ante*. Defendant quotes from Tyler vs. Boston, 7 Wall., 327, where the Court said that where a patent is for new substance it should state the component parts with clearness and precision. The particular example given in the specification was crude fusel oil 1 part and kerosene 1 part. The patent stated, however, that naphtha, etc., might be substituted for the kerosene and that the proportion of fusel oil might be varied. The claim referred to the fusel oil and to the other ingredient as mineral or earthy oils and stated no proportions. Defendants used naphtha 72 parts and fusel oil 28 parts. The claim was not voided because of its generality. The question was whether one compound of given proportions was the equivalent of another compound

varying in the proportions and the Court after saying that the term "equivalent" "means equally good," held it was a question for the jury.

Defendant cites Cochrane vs. Badische, 111 U. S., 293, 310, where the Court said:

> "Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process."

With this we agree for here the claims do identify the product apart from the process and so-called base tests, and the facts in the case at bar clearly distinguish it from the case cited.

Bene vs. Jeantet, 129 U. S., 683, is also distinguished in a similar manner. See our main brief, page 155.

The Incandescent Lamp Case, 159 U. S., 468, is also readily distinguished from the case at bar. In the Incandescent Lamp case, the Sawyer & Man patent in suit related to the filament of an incandescent lamp. The patentees stated they had made use of "carbonized paper and also wood carbon." The patent apparently did not specify any particular kind of paper or wood as being suitable and apparently many kinds were not suitable. The alleged infringing lamp was the Edison lamp in which a special kind of bamboo was used for the filament. The Sawyer & Man patent contained a claim 3, reading

> "The incandescing conductor for an electric lamp formed of carbonized paper substantially as described."

Wood carbon had been previously used as an incandescing conductor, but the Court held the claim valid, though concededly not infringed and although the claim was merely for a different material having the incandescing properties.

There was also a broader claim in suit, to wit, one which defined the filament broadly as "an incandescent conductor for an electric lamp of carbonized fibrous or textile material" and it was claimed that the Edison carbonized bamboo filament infringed this claim. The Court found that the Sawyer & Man lamp

> "was never a commercial success; that it does not embody the principle of high resistance with a small illuminating surface; that it does not have the filament burner of the modern incandescent lamp; that the lamp chamber is defective; and that the lamp manufactured by the complainant and put upon the market is substantially the Edison lamp."

And it was Edison, who, after finding over six thousand vegetable growths unsuitable, finally discovered one or two special varieties of bamboo which could be successfully used and it was by Edison's brilliant discovery and not that of Sawyer & Man that art was revolutionized. It was, as the Court said, **"under these circumstances"** unjust to hold that the one who had made the real invention should be held an infringer of a paper patent which had contributed nothing of value to the practical art (just the reverse in the case at bar). But the Court further held that if the claim be given a sufficiently broad construction as to include all carbonized fibrous filaments, including Edison's, then it would be anticipated, for it was shown that carbonized fibrous material such as wood had been used before Sawyer & Man, and such is far from the situation in the case at bar.

But the cited case, in fact, sustains our contention for the Court said (p. 476):

> "If Sawyer and Man had disovered that a certain carbonized paper would answer the purpose, their claim to all carbonized paper would, perhaps, not be extravagant."

In other words if Sawyer & Man discovered one carbonized paper suitable for the purpose, their claim of all

carbonized paper would be good even though some carbonized papers might not be suitable. In such case the claim would be construed as covering any carbonized paper suitable for the purpose. Such is the commonly accepted mode of interpretation in such cases.

Matheson vs. Campbell, 78 Fed., 910, and American vs. Mesta, 18 Fed. (2nd), 538, were distinguished at pages 155, 156, of our main brief.

The Product Claims Are Not Limited to the So-called 9 to 1 and 170 Degree Tests.

These limitations are process limitations and where, as here, the product is claimed independently of such process features, it is not limited thereto. This point is discussed at pages 134, 135, of our main brief, but we may add thereto the following cases,

In Maurer vs. Dickerson, 113 Fed., 870, 874; 51 C. C. A., 494, the Circuit Court of Appeals for the Third Circuit said:

> "Since, then, there was novelty both in the process and product, Hinsberg might have had one claim for the process and another claim for the product. Rubber Co. vs. Goodyear, 9 Wall., 788, 796, 19 L. Ed., 566; Merrill vs. Yeomans, 94 U. S., 568, 569, 24 L. Ed., 235. But he made the single claim quoted at the opening of this opinion. That claim, in terms, is for the described product, having certain distinguishing characteristics which are set forth in the claim with great fullness. In our judgment, it is very clear that the claim is not restricted to the product made by the described process, but covers the chemical individual, however, produced."

And in Dunn vs. Toronto, 259 Fed., 258, the Court said,

> "Certain it is, in view of the weight of authority and the latest decisions, that the inventor of a new and useful product or article of manufacture may have a patent which covers it and gives a monopoly upon it

regardless of great variations in the method of making (Powder Co. vs. Powder Works, 98 U. S., 126, 136, 137, 25 L. Ed., 77; Leeds Co. vs. Victor Co., 213 U. S., 301, 318, 29 Sup. Ct., 495, 53 L. Ed., 805; Durand vs. Schulze (C. C. A., 3), 61 Fed., 819, 821, 10 C. C. A., 97; Maurer vs. Dickerson (C. C. A., 3), 113 Fed., 870, 874, 51 C. C. A., 494; Lamb vs. Lamb (C. C. A., 6), 120 Fed., 267, 269, 56 C. C. A., 547; Sanitas Co. vs. Voigt (C. C. A., 6), 139 Fed., 551, 552, 553, 71 C. C. A., 535; Acme Co. vs. Commercial Co. (C. C. A., 6), 192 Fed., 321, 325, 326; 112 C. C. A., 573."

We quite agree with defendant's citation of Matheson vs. Campbell, 78 Fed., 910, for the Court there said:

> "An inventor takes certain starting materials, and subjects them to a process he has devised. The result is a product. If he sufficiently describes the starting materials and the process in his patent, he may claim the product, being new; (independently of the process and independently of the condition of the starting materials at the start), but if he simply defines what he claims as the 'product of his process' he might find it an extremely difficult matter to prove infringement. * * * Now, there are many tests that may be applied to two bodies which are being compared in order to determine whether they are or are not identical. The number of these tests may be multiplied indefinitely, for the skill, the experience, the scientific ingenuity of the chemist will ever devise new ones in the future, as they have old ones in the past. * * * and when, out of the multitudinous qualities which his product may exhibit under varying conditions and in different relations, he has selected and set forth in his patent a chosen few, surely these should be accepted as the distinguishing earmarks,—the characteristic stigmata of the product his patent is to cover." (Part in parenthesis ours.)

And so in the case at bar where Perkins has selected a chosen few characteristics as distinguishing his invention and set them forth in the product claims in suit, it follows that he should not be limited to others which he has not so

chosen and especially those which are merely characteristic stigmata of a preferred base, a different product. As stated in Motion Picture Patents Co. vs. Universal, 243 U. S., 502, 510 (also cited by defendant).

> "It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute."

The Disclaimer Question.

This is quite fully treated at pages 141-150 of our main brief, but at page 39 of its reply brief, defendant has injected the colloquy between the Court and counsel in the Hood-Wright case with respect to the effect of the disclaimer on process claim 13, i. e., one of the claims mentioned in the disclaimer and not one of the product claims here in suit as to which no disclaimer was filed. We quote the colloquy in full with our explanations in parenthesis. See footnote below.

"The Court: Just tell me what portion, according to your idea anyway, of claim 13 is covered by the disclaimer?

"A. Claim 13 illustrates the *process* of making wood glue which consists in treating a suitable starchy carbohydrate a material portion of which is substantially insoluble in water with a solvent of cellulose, etc. The scope of that claim—perhaps I should say the meaning of that claim, technically—

"Mr. Crosby: If I may interrupt your Honor, it seems to me that is a question of law as to how the disclaimer applies, rather than a question for the expert. I thought it was perfectly clear from our interpretation of the disclaimer, that it limits that claim so that no process is covered (by it) except where the dissolving step is applied to the base, already suitably degenerated as described by Perkins. That is our interpretation of it.

"The Court: That may be, but this witness is attempting to apply this claim to the *process* of the defendant, and in the application there must be eliminated such part as is covered by the disclaimer. What I am trying to get at from the witness is just exactly what the *claim* is after eliminating that part covered by the disclaimer in making his application.

(*Footnote continued on next page.*)

We submit it is unfair for defendant's counsel to thus take the remarks which had reference solely with respect to the

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"Mr. Crosby: That is what we have felt was a question of law. We have no objection on our part to having the witness give his view-point of it, which is, as I understand, he said in the answer, that the disclaimer merely limits the *claim* to a *process* in which the base used is one degenerated to the point specified by Perkins as distinguished from a *process* in which that dissolving step might be applied to some other base. The disclaimer reads—

"The Court: I know how it reads.

"Mr. Crosby: That he excepts from *that claim*—that, he does not intend to cover *in that claim* any *process* excepting where the base used in the process is one degenerated to that point; whereas the claim, without the disclaimer, might be implied to include some other base.

"The Court: What for example?

"Mr. Crosby: One not degenerated to the proper point.

"The Court: To what point?

"Mr. Crosby: (Some) Entire raw starch, which would not produce Perkins' glue but some entirely different product.

"Mr. Kenyon: The Circuit Court of Appeals in Chicago said that our second step, per se, was not an invention, new with us; that is, simply treating starch, any kind of starch, with water and this caustic; that is (the process) was only ours when it stated with a suitably degenerated carbohydrate, then these steps of water and caustic produced our glue; but if those steps, those identical steps of water and caustic and those identical amounts had been applied to absolutely raw (highest viscosity) starch (in the way Perkins described without adjustment of conditions) we would not have produced our glue (under claim 13). The Circuit Court of Appeals said, therefore, you can't have the (process) claim as broad as that. We said to Judge Sanborn that word 'suitable' enables you to construe that claim down to the real limits of our (process) invention, namely, the application of that second step, water and caustic, in those quantities, to a carbohydrate suitably degenerated. Judge Sanborn said 'no.' I think the Circuit Court of Appeals meant that that was the claim for the second step, per se, irrespective of what you started with, therefore, it is broader than your (process) invention, because it covered, for instance, the application of these two steps to *absolutely* raw starch, which would not give us our glue (but an unworkable jelly). It also might cover the use of soluble starch or dextrine which would produce a watery size or mucilage. Therefore, we disclaimed from *that claim, if it covered it*—we disclaimed from *that claim* the treating by three parts or less of water and this caustic any kind of starch except a starch that has been degenerated to the point that we have described. Now the (process) claim, as limited by the disclaimer, is for the subject matter that is left, namely, for starting with the so degenerated starch,

(*Footnote continued on next page.*)

scope of certain process claims and use them in a manner calculated to lead the Court to believe that they had reference to the product invention. If the disclaimer as a matter of law applies to and limits the scope of the glue product claims, such misapplication of plaintiff's remarks cannot help defendant's cause, and if the disclaimer as a matter of law does not affect the glue product claims, no statement of any counsel can make it do so.

Defendant's Statements With Regard to the Solva Case are Misleading.

In the Solva Case there were several starch bases involved. One was made by a preliminary degeneration process like Perkins and probably fell within the 9 to 1 boil up test. Most of the Solva base was, however, raw starch (like defendant's here) and there was no evidence that it responded to either the 9 to 1 or 170° tests. Defendant, however, says (p. 32 of its Reply Brief) that this

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and with that as the subject matter of the treatment applying the three parts or less of water and the caustic and getting the result that is specified. That is our (claim 13 process) invention. The claim, with the disclaimer, is clearly in terms limited to that. Without the disclaimer it might have been as broad as Judge Sanborn seems to have considered it, and, therefore, broader than our (process) invention. So the thing disclaimed (from claim 13) to put it crudely, would be the mixing of raw starch, that is the wholly undegenerated starch, for example, with three parts or less of water, and six to ten per cent. of caustic and trying to see what you would get. You would not (following Perkins' method of dissolving and without changing the conditions of mixing) get our glue under those circumstances; you would not have our (claim 13 process) invention under those circumtances. We do not want to cover that (in claim 13); the defendant may do that (so far as claim 13 is concerned). Therefore, we disclaimed that (from claim 13), but what is left (in claim 13), is the starting with a starch that is degenerated to the point that our patent describes as the (process) subject matter of the patent, the mixing of that starch and nothing else with three parts or less of water and with the caustic, and getting as a result of that combination the good as animal glue that Perkins first gave to the world, and that the defendant is enjoying the benefit of."

base behaved just like the processed goods when tested and the Solva Co. tested it the same way they did the processed goods and it tested the same. Defendant would apparently have the Court believe that it was tested by the so-called 9 to 1 boil up or 170° test. But such was not the fact. The evidence in the Solva Case showed that it was tested by dissolving it in between 2 and 3 parts of water with the caustic and seeing if the good as animal glue of the patent resulted, i. e., the test which defendant's expert and the Court in the Solva Case said was the fundamental and final determining test (see our main brief, p. 157). But on page 32 of their reply brief defendant's counsel say

> "In the words of plaintiff's own counsel, this particular raw starch was 'a starch * * * found in commerce already modified so that its viscosity is two or three times that of water by the Perkins test.' "

We submit plaintiff's counsel said no such thing. What plaintiff's counsel said was:

> "If a starch be found in commerce already modified so that its viscosity is two or three times that of water by the Perkins' test, then it may not be necessary to further modify it,"

and a reference to the record in the Solva Case shows that there is no justification for defendant's statement or inference. Neither plaintiff's statement nor the record supports defendant's contention that the Solva raw starch base (the glue made from which was held to infringe) responded to either the 9 to 1 boil-up test or the 170° test.

It is true that in the Solva case, for the purpose of showing that certain starches used at Poplar Bluff did not anticipate the glue **base** claim there in suit, plaintiff argued (see pp. 32-34, Defendant's Reply Brief) that these were many times more viscous than those which responded to the 9 to 1 boil up test and plaintiff there argued for a

limited construction of the glue **base claim** to avoid this and other prior art **bases**. But the Court in the Solva Case did not adopt plaintiff's contention. It gave a much broader range to the base, holding (251 Fed., 69) that as to the tests for the base

> "The most satisfactory of these is to apply the second step of the patent, and if the result is the veneering glue of the patents, the operator has guessed right,"

and the Court accordingly held the claim for the base invalid. We submit defendant is not justified in asserting that plaintiff is now bound by its then contention which was thus overruled by the Court and whose decision it accepted.

Respectfully submitted,

GORHAM CROSBY,
Counsel for Respondent.

S. MORTIMER WARD, JR.,
of Counsel for Respondent.

APPENDIX.

The great variety of forms of characteristics used in product claims is illustrated by the following cases:

Polygon Corp. vs. *Kant-Rust Corp.*, 292 Fed., 569. One of the claims read:

> "6. A penetrating adhesion freeing solution for releasing rust films between adherent surfaces comprising a volatile penetrating corrosion solvent and an oily vehicle for the solvent having a volatilization retarding relation to the solvent."

It appeared that defendant used elements different from those stated in the specification, but the Court said:

> "The objection that some of these elements are not mentioned in the specification carries no weight. Abbott was not bound to foresee and state every substance that could be used. To require that would be to require prophesy as to the price of patenting."

Badische vs. *Kalle*, 94 Fed., 163. Here one characteristic was a dye product "resembling indigo in color," etc., and the claim also stated the dye "is very fast to light and washing" i. e., characteristics of usefulness, and the Court said (p. 174):

> "To produce a cheap, artificial, soluble substitute for indigo, possessing many of its advantages and in some respects superior to indigo, was surely no mean achievement."

The defendant there advanced much the same plausible arguments as defendant herein advances, but the Court said (p. 171):

> "If one discovers a new and useful product he is entitled to the full benefit thereof no matter how it may be produced."

Holliday vs. *Pickhardt*, 29 Fed., 853, 860. The following claim was sustained:

> "I claim as my invention (1) the sulpho-conjugated compound of rosani-line, possessing the properties specified, as a new article of manufacture."

Pickhardt vs. *Packard*, 22 Fed., 530. The Court said:

> "It was not shown by the complainants that the defendants' coloring matter was made by the process described in the patent, nor was any evidence to the contrary produced by the defendants. The proofs show satisfactorily, however, that the defendants' coloring matter possesses the peculiar characteristics of the patented article."

Kraft Cheese Co. vs. *Pabst Co.*, 17 Fed. (2nd), 787. One of the claims read:

> "As a new article of manufacture, completely sterilized cheese of the Cheddar genus."

Theroz Co. vs. *Chemical Co.*, 14 Fed. (2nd), 629. One of the claims read:

> "1. An artificial fuel consisting of cellulose, having a nitrogen content, which renders it soluble in methyl alcohol, methyl alcohol and ethyl alcohol, substantially as described."

It will be noted that the claim does not state any proportions nor what particular compound should be used for nitrogen content and it appeared that defendant used very different proportions from those of plaintiff. The Court held the claim valid and infringed, saying (p. 635):

> "It is the duty of the court to avoid, if it reasonably can, a construction confining the patent to the precise method of manufacture which it describes."

Chadeloid vs. *DeRonde Co.*, 146 Fed., 988. The defendant used entirely different proportions than those specified in the patent and defendant did not use the methyl alcohol specified in the patent but used acetone instead, which, however, the Court found to be an equivalent because it was "equally good" and, therefore, held the claims valid and infringed.

Keasbey & Mattison Co. vs. *Carey Co.*, 139 Fed., 571. One of the claims read:

> "(3) The non-conducting composition herein described, consisting of a major proportion of carbonate of or calcined magnesia, which forms of itself the principal non-conducting element of the composition, and a minor proportion of asbestos fiber sufficient to bind the magnesia together, as herein set forth."

Dunn Co. vs. *Toronto Co.*, 259 Fed., 258. The product claim read:

> "As an article of manufacture, a wire-cut brick having wire-cut ribs on the side thereof, substantially as set forth."

Rumford Works vs. *New York Co.*, 134 Fed., 385. One of the claims read:

> "A baking preparation containing phosphoric acid or its compounds in granular condition essentially free from pulverulent phosphatic material, substantially as described."

Although the claims recite no proportions the Court held them valid and infringed saying (p. 388):

> "The defendants' powder is known as 'Lion Baking Powder.' Assuming, as defendants contend, that it contains from 10 to 12 per cent. of phosphatic material,

> which will pass through a No. 16 silk bolt, and may be denominated pulverulent, nevertheless we think the phosphatic element is generally granular in condition and essentially free from pulverulent matter. It is sufficiently so to produce all the results claimed by the patent."

Maurer vs. *Dickerson*, 113 Fed., 870. The product claim was:

> "The product herein described, which has the following characteristics: It crystallizes in white leaves, melting at 135° centigrade; not coloring on addition of acids or alkalies; is little soluble in cold water, more so in hot water; easy soluble in alcohol, ether, chloroform, or benzole; is without taste; and has the general composition $C_{10}H_{13}O_2N$."

And although the claim did not specify what acids or what strength of acids or alkalis should be used in making the color test, and it appeared that acids of certain strengths under certain conditions would not work, the Court held the claim valid and infringed because defendants article responded to all the tests specified in the *claim*, and the Court said (p. 874):

> "In our judgment, it is very clear that the claim is not restricted to the product made by the described process, but covers the chemical individual, however produced."

Farbenfabriken, etc., vs. *Kuehmsted*, 171 Fed., 887. Here there was a claim for a chemical product. The Court said:

> "As to infringement, the substance sold by defendant answers to all the tests prescribed by the patent claim."

And the Court found infringement based on the tests in claim and not on other tests.

There was no evidence that the defendant used the same process as that described in the patent.

Union Carbide Co. vs. *Carbolite Co.*, 188 Fed., 334. The claim reads:

> "As a new product, crystalline calcium carbide existing as masses of aggregate crystals, substantially as described."

General Bakelite Co. vs. *Insulate Co.*, 276 Fed., 166. One of the claims read:

> "As a new composition of matter, a fibrous or cellular material impregnated with an infusible and insoluble condensation product of phenol and formaldehyde."

General Bakelite Co. vs. *Nikolas*, 225 Fed., 539. Here one of the claims set forth no proportions but characterized the product by its **capability**. The claim read:

> "A varnish containing a volatile organic solvent and a condensation product of a phenolic body and formaldehyde, said condensation product characterized by its capability of transformation under the action of heat into an insoluble and infusible body, and by the presence therein of a base condensing agent."

General Electric vs. *Laco-Philips*, 233 Fed., 96. The Court said:

> "The inventors state their object and their claims in language characterized by clearness and simplicity. They say:
>
> " 'The present invention has for its object incandescing filaments for incandescent electric lights or lamps composed of substantially pure tungsten.' "

And they claim:

> "1. A filament for incandescent
> tungsten in a coherent metallic stat
> throughout."

Hemolin Co. vs. *Harway Co.*, 131 Fe
read:

> "(3) As a new article of manu
> matter derived from logwood extr
> ration therewith of an alkaline nit
> ized by the fact of its being a fria
> cold and rapidly soluble in hot wat
> described."

Products Co. vs. *Milk Co.*, 293 Fed
claims held valid was:

> "A liquid composition compris
> emulsion of chocolate and milk."

although it stated no proportions.

ent lights consisting of
state and homogeneous

Fed., 483. The claim

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